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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,352	01/19/2001	Takahiro Masuda	1046.1234/JDH	7139

21171   7590   10/03/2005

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EXAMINER
CHOW, CHIH CHING

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/764,352	MASUDA ET AL.
	Examiner	Art Unit	
	Chih-Ching Chow	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-13</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 April 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/16/01</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to amendment dated July 06, 2005.

2.   Per Applicants' request, the Specification, claims 1-12 have been amended, claim 13 is added.

3.   Claims 1-13 remain pending.

Response to Amendment

4.   Applicants' amendment dated 07/06/2005, responding to the 04/07/2005 Office action provided in the objection of <u>Specification</u>. The examiner has reviewed the updated <u>Specification</u> respectfully.

5.   The amended <u>Specification</u> recites (paragraph 13) "In many cases, these reserved words and the syntax pattern depend on a version of the application program. For example, depending on the application program, one version of the application program may use different rules for instructing a computer (or other processing devices) to perform specific tasks in comparison to another version of the application program. Accordingly, most application programs define their own syntactical rules that control which words and/or instructions the computer understands. Thus, determining a version of the most suitable application program to open a document or a data file includes analyzing the document or data file and extracting the reserved words and/or syntax patterns. Because the extracted reserved words and/or syntax patterns depend on a version of an application program used to create the reserved words and/or syntax patterns, the reserved words and/or syntax patterns are used as an indication of a suitable application program to read the document or data file. Based upon the result of an analysis of various versions of application programs, both a document or data file and application programs of various corresponding versions are displayed at the same time on a display apparatus." – The amended <u>Specification</u> has been fully considered respectfully by the examiner but they are not persuasive. The amended <u>Specification</u> above reveal the following questions:

    a. Is the syntax pattern and the reserve words depend on the version or the version depend on the syntax pattern and the reserve words (feature points)?

    See amended paragraph 13, "these reserved words and the syntax pattern <u>depend on a version</u> of the application program" – implies that syntax pattern and the reserve words depend on a <u>version</u> of the application program. However, see Abstract of the current application, "a feature point as reserved word of macro instruction is extracted, and <u>a version of an application suited for the document file is distinguished by an extracted feature point</u> – this implies that the feature points are the reserve words, and a version of an application suited for the document file is distinguished by an extracted feature point.

    b. How can a user obtain the analysis result based on the amended <u>Specification</u>? (see paragraph 14, "users may select any one of these application programs to open this document file among various versions. In this case, based on information provided by an analysis result").

    c. Does the version got extracted first or the feature points? And how? See amended Specification, "determining a version of the most suitable application program to open a document or a data file includes analyzing the document or data file and extracting the reserved words and/or syntax patterns. Because the extracted reserved words and/or syntax patterns depend on a version of an application program used to create the reserved words and/or syntax patterns, the reserved words and/or syntax patterns are used as an indication of a suitable application program to read the document or data file".

6.   Applicants' amendment filed on 07/06/2005, responding to the 04/07/2005 Office action provided in the <u>35 USC § 112 (1) rejections</u> for claim 5. The Examiner has reviewed the amended claim 5 respectfully.

7.   The rejection to the 35 USC § 112(1) rejections is maintained since the Applicant has failed to explain the amended 'symbol figure' in the amended <u>Specification</u>.

8.   Applicants' amendment filed on 07/06/2005, responding to the 04/07/2005 Office action provided in the <u>35 USC § 112 (2) rejections</u> for claims 1, 2, 3, and 8. The Examiner has reviewed the amended claims 1, 2, 3, and 8 respectfully.

9.   The 35 USC § 112(2) rejection for claims 1, 2, 3 is maintained since the amended Specification, claims 2 and 3 still do not explain the relationship between the 'macro instruction' and the 'extracting'.

10.   The 35 USC § 112(2) rejection to claim 8 is hereby withdrawn in view of Applicants' amended claim 8.

11.   Applicants' amendment for Claims 1-12, and claim 13 have been fully considered respectfully by the examiner but they are not persuasive.

Response to Arguments

12.   Applicant's arguments with respect to claims 1-12 and claim 13 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendments to the claims.

13.   The Examiner is maintaining the 35 USC § 112, the 35 USC § 102, and 35 USC § 103 Rejections; in addition, the Examiner is also listing the Priority objection, and the 35 USC § 101 rejection. For the Applicants' convenience they are listed as following, with the amendments requested by the Applicants.

Priority

14.   Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. JP 2000-115239 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Claim Rejections - 35 USC § 101

15.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16.   Claims 1, 4, and 13 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Claim 1 recites

'An installation method of an application program,

comprising:

extracting a feature point in a data file after having analyzed the data file, the feature point being indicative of a format used to create the data file;

selecting a version of the application program suited for the data file based on the extracted feature point;

determining whether the selected version of the application program is already installed; and

installing the selected version of the application program upon determining that the version of the application program is not installed."

Claim 4 recites

'An activation method of an application program, comprising:

extracting at least one of a plurality of feature points in at least two data files after having analyzed the data files, the feature points being indicative of corresponding formats used to create the data files;

selecting a version of the application program in which a data file is readable based on at least one of the feature points;

displaying simultaneously the readable data file and the application program of a version decided thereby; and

activating the displayed application program in relation to any one of the analyzed data files.'

Claim 13 recites

'A method of automatically installing an application program, comprising:

   analyzing a data file to determine a format thereof and determining a version of an application program used to create the data file based on the determined format of the data file; and

   automatically installing the version of the application program or a substantially similar version of another application program able to read the data file upon determining that a suitable application program to read the data file is not installed.'

The language of the claims raise a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 USC § 101.

   Furthermore, under the most recent Federal Circuit cases, transformation of data by a machine (e.g., computer) is statutory subject matter provided the claims recite a "practical application, which produce[s] a useful, concrete and tangible result." <u>State St. Bank & Trust Co. v. Signature Fin. Group, Inc.</u> 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998).

   In this instance, the Office's interpretation of this claim is that it does not expressly or implicitly require performance of any of the steps by a machine such as a general-purpose digital computer. Structure will not be read into the claim for the purposes of the statutory subject matter analysis although the steps might be capable of being performed by a machine.

   On this basis, Claim 1 is rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

   Claims 2, 3, 8 are dependent claims of claim 1, therefore they are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter for the same reasons set forth in the rejection of claim 1.

Claims 5, 6, 7 are dependent claims of claim 4, therefore they are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter for the same reasons set forth in the rejection of claim 4.

Claim Rejections - 35 USC § 112

17.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18.   Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 5 recites "The activation method mentioned in claim 4, wherein: the readable data file is displayed with a symbol figure by each version corresponding to the application program." – what does a 'symbol figure' look like? It's not explained in the Specification.

19.   Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 13 recites "A method of automatically installing an application program, comprising:

analyzing a data file to determine a format thereof and determining a version of an application program used to create the data file based on the determined format of the data file; and

automatically installing the version of the application program or a substantially similar version of another application program able to read the data file upon determining that a suitable application program to read the data file is not installed." — the 'substantially similar version' is not explained in the Specification.

20.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "extracting a feature point of a data file after having analyzed the data file" – it's not clear from the Specification, how does the 'extracting a feature point in a data file' is done.

22.   Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The 'extracting the reserved word' is done, and how does the 'extracting' related to the 'macro instruction' recited in the first part of claim 2?

23.   Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It's not clear how does the 'extracting the syntax pattern' is done, and how does the 'extracting syntax pattern' related to 'the macro instruction' included in the data file?

Claim Rejections - 35 USC § 102

24.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

25.   Claims 1-3, 8, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6199204 by Donohue.

CLAIMS	Donohue
1. An installation method of an application program comprising: (a) extracting a feature point in a data file	Donohue teaches a method for automatically installing computer programs. For item a, in Donohue's

after having analyzed the data file, the feature point being indicative of a format used to create the data file;

invention column 8, line 32-35, "Assuming that software vendors provide via their Web sites a list 60 of available product updates referenced by **product identifier** and **release number** 110 (or some other consistent naming convention is used)"; the 'extracting' is done in Donohue, see column 4, lines 14-21, "compares the available relevant updates with **update criteria held on the local computer system** (these update criteria are predefined for the current system or system user), and then automatically downloads and applies software updates which satisfy the predefined criteria." – the predefined criteria needs to be extracted in order to be compared; the 'feature point' can also be used as an indicative of an installation data, see example in Donohue's disclosure, column 10, lines 16-20, "the software product to be updated may be a word processor application program. If the word processor as sold missed certain fonts or did not include a thesaurus, patches may subsequently be made available for adding these <u>features</u>. The updater component has the capability to add these to the word processor, subject to the update criteria".

The "release number" is the same as the "version of an application" (item (b)). On Donohue's Fig. 2, the table shows the software product identifier along with the associated version number. Therefore, once a 'feature point' is identified (extracted) the version number can be determined (claim 1 (a), (b)).

(b) selecting a version of the application program suited for the data file based on the extracted feature point,

(c) determining whether the selected version of the application program is already installed; and

Donohue column 8, line 65-67 shows "a comparison 250 between the current installed software product's identifier and release number and the listed available updates in the retrieved file 160. This comparison determines possible growth

(d) installing the selected version of the application program upon determining that the version of the application program is not installed.	paths form the current to updated versions... Thus, the updater component determines whether the available new versions and whether it is possible to apply patches to the current version..." The comparison is determining whether an application should be installed (claim 1 (c)). Assuming this means install the application program if it's not currently installed yet (see rejection on 112 2nd paragraph for claim 1 (d)). Donohue teaches the feature extracting and version comparison, but does not install the software unless the software meets the 'predefined update criteria'.
8. The installation method mentioned in claim 3, further comprising: eliminating an existing file if insufficient space exist when the application program is executed.	See 112 (2nd) rejection above. It's well-known for the people in the art that when installing new file into a computer, if insufficient space occurred, the computer will put out a warning for the user, the user will have to eliminate existing file in order to restore more space in the computer.
11. An apparatus for installing an application program, comprising: (a) an extracting unit extracting at least one of a plurality of feature points in a data file after having analyzed the data file; the feature point being indicative of a format used to created the data file; (b) a selecting unit selecting a version of the application program suited for the analyzed data file based on an extracted feature point; (c) a judging unit judging whether the application program of a decided version is already installed; and (d) an installation unit installing the application program of the version when the decided version of the application program is not installed.	See claim 1 rejection.

12. A storage medium storing an application program, which when executed by a computer, sequentially executing:

(a) extracting at least one of a plurality of feature points of a data file after having analyzed the data file, the feature point being indicative of a format used to create the data file;

The program is executing the updates has to be stored somewhere in the system in order to be executed. For item (a), see the rejection of claim 1 (a).

(b) selecting a version of the application program suited for the analyzed data file based on an extracted feature point;

See the rejection of claim 1(b).

(c) judging whether the application program of a decided version is already installed; and

See the rejection of claim 1 (c).

(d) installing the application program of the version when the decided version of the application program is not installed.

See the rejection of claim 1(d).

13. A method of automatically installing an application program, comprising:

(a) analyzing a data file to determine a format thereof and determining a version of an application program used to create the data file based on the determined format of the data file; and

(b) automatically installing the version of the application program or a substantially similar version of another application program able to read the data file upon determining that a suitable application program to read the data file is not installed.

For item (a) see claim 1 rejection, for item (b), see 112(1) rejection above.

Claim Rejections - 35 USC § 103

26.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27.   Claims 4-7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent No. 6199204 by Donohue, as applied to claims above, in view of U.S.

Patent No. 6282712 by Davis et al (herein after Davis).

CLAIMS	Donohue / Davis
4. An activation method of an application comprising: (a) extracting at least one of a plurality of feature points in at least two data files after having analyzed the data files, the feature points being indicative of corresponding formats used to create the data files; (b) selecting a version of the application program in which a data file is readable based on at least one of the feature points; (c) displaying simultaneously the readable data file and the application program of a version decided thereby; and (d) activating the displayed application program in relation to any one of the analyzed data files.	In Donohue, column 7, lines 62, Each vendor is assumed here to make available via their Web Sites such a list 60 of software updates (an example of which is shown in Fig. 2). Fig. 2 shows software updates list and retrieved software list; both the data file and the application program are **displayed** in web site for the user to access. Therefore it covers item (c). Donohue teaches the means of 'retrieving' (*activating*) the application program. In Donohue's claim 1, 3rd and 4th items, "means for **initiating retrieval** of software update resources which satisfy said predefined criteria; and means for applying a software update to one of the installed computer programs using the **one or more** retrieved software resources." Donohue also teaches the 'feature points being indicative of corresponding formats used to create the data files", see claim 1 (a) rejection. Donohue teaches all the aspects of claim 4, but Donohue doesn't specifically allow the user to select certain application program, item (d). However Davis shows the feature to allow the user to manually select an application program in an analogous art for the purpose of ensure that the application program installation is necessary and appropriate (implied from Davis BACKGROUND OF THE INVENTION). In Davis' claim 1, 4th and 5th items, "**selecting an edition** of the software....", "automatically installing the **selected edition** of the software onto the new computer ...". It would have been

obvious to a person of the ordinary skill in the art at the time of the invention to modify Donohue's updating software application disclosure with the user selection feature taught by Davis for the purpose of facilitating the installation of software within their distributed system (See Davis BACKGROUND OF THE INVENTION).

5. The activation method mentioned in claim 4, wherein: the readable data file is displayed with a figure corresponding to the application program.	For the features of claim 4 see Donohue and Davis. Davis' disclosures display user readable 'symbol figure' for user to select. See claim 4 rejection.
6. The activation method mentioned in claim 4, wherein: only the readable data file corresponding to a version of the application program is displayed when the application program is selected.	Same as claim 4 rejection.
7. The activation method in claim 4, wherein: the installation of a corresponding application program is executed when an application program corresponding to the data file does not exist.	Same as claim 4 rejection.
9. A computer-readable medium on which an application program is recorded, the application program when executed by the computer, causes the computer to execute the functions comprising: (a) extracting at least one of a plurality of feature points in at least two data files after having analyzed the data files, the feature points being indicative of corresponding formats used to create the data files;	In Donohue's claim 1, "A computer program product, comprising computer program code recorded on a computer readable **recording medium**, ..." Here Donohue teaches us a record medium for a software update system. For claim 9 (a) see the rejection of claim 4 (a).
(b) selecting a version of the application program which can read the readable data file based on at least one of the feature points;	See the rejection of claim 4 (b).
(c) displaying simultaneously the	See the rejection of claim 4 (c).

readable data file and the application
program of a version decided thereby;
and
  (d) activating the displayed application   See the rejection of claim 4 (d).
program in relation to any one of the
analyzed data files.

10. An apparatus for executing an   See the rejection of claim 4 (a).
application program, comprising:
  (a) an extracting unit extracting at least
one of a plurality of feature points of at
least two data files after having analyzed
the data files, the feature points being
indicative of corresponding formats used
to create the data files;
  (b) a selecting unit selecting a version of   See the rejection of claim 4 (b).
the application program which can read
the readable data files based on at least
one of the feature points;
  (c) a displaying unit simultaneously   See the rejection of claim 4 (c).
displaying the readable data file and the
application program of a version decided
thereby; and
  (d) an activating unit activating the   See the rejection of claim 4 (d).
displayed application program in relation
to any one of the analyzed data files.

Conclusion

The following summarizes the status of the claims:

35 USC § 101 rejection: Claims 1-8, 13

35 USC § 112 (1) rejection: Claims 5 and 13

35 USC § 112 (2) rejection: Claims 1-3

35 USC § 102 rejection: Claims 1-3, 8, 11-13

35 USC § 103 rejection: Claims 4-7, 9-10

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Ching Chow whose telephone number is 571-272-3693. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the **TC2100 Group receptionist: 571-272-2100**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Ching Chow

Examiner

Art Unit 2192

September 26, 2005

CC

ANTONY NGUYEN-BA
PRIMARY EXAMINER